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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/190,993 11/12/98 PALTENGHE

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EXAMINER

TM02/0615

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ART UNIT

PAPER NUMBER

2161

DATE MAILED:

06/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/190,993

Applicant(s)

PALTENGHE ET AL.

Examiner

John W Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 26 April 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/190,993 is acceptable and a CPA has been established. An action on the CPA follows.

Information Disclosure Statement

2. The information disclosure statement filed 27 February 2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because some of the cited references were not provided in the English language. Specifically, the references to Weib [DE 44 27 039 A1], Achtert [DE 195 28 883 A1] and "Combicard – Eine Karte Fuer Alles, " Ntz Nachrichtentechnische Zeitschrift, DE, VDE Verlag GMBH, Berlin, Vol. 49, No. 5, p. 33, XP000596205, May 1, 1996 were not provided in the English language and were not initialed by the Examiner on the attached PTO-1449. Also, applicant has not provided a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language as required by 37 CFR 1.98 (a)(3). These references have been placed in the application file, but the information referred to therein has not been considered as to the merits. Examiner notes that all other references cited on the attached PTO-1449 have been considered. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Response to Arguments

3. Examiner notes that Applicant has filed a Continued Prosecution Application, however, has neither provided an amendment to the claims nor arguments pointing out disagreements with the examiner's contentions in the previous Final Office Action by discussing the references applied against the claims, explaining how the claims avoid the references or distinguish from them. For these reasons, this action will be made final.

Drawings

4. The drawings filed on 12 November 1998 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required.

5. Applicant is required to submit a proposed drawing correction, however, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Williams et al*, U.S. Patent No. 6,016,484 in view of *Teicher*, U.S. Patent No. 5,744,787.

As per claim 14, *Williams et al* discloses a virtual wallet system comprising a locally residing wallet portion, an external server residing wallet portion and further discloses exchanging first data from a local portion of the wallet into a point of sale device wherein the first data includes a transactional amount

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(Col. 11 lines 59-67; Col. 12, lines 46-50; Col. 12 line 66-Col. 13 line 17; Col. 14, lines 5-25; Col. 16, lines 34-54). *Williams et al*, however, fails to specifically disclose synchronization between the local and server portions of the wallet by receiving and storing at the server portion an electronic voucher indicative of the good purchased and receiving a request for the electronic voucher at the server portion and providing the good to a user. *Teicher* discloses a system and method for making purchases with an electronic wallet that includes a local wallet portion and an associated server portion at a financial institution and teaches receiving and storing at the server portion an electronic voucher indicative of the purchase and receiving a request for the electronic voucher at the server portion of the wallet (Col. 7 line 60-Col. 8 line 3; Col. 8, lines 9-14; Col. 9, lines 21-30; Col. 10, lines 3-8 and 15-32) and providing the good to a user upon receipt of the electronic voucher (Col. 11, lines 57-65). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of *Williams et al* and include the steps of synchronizing the local and server portions of the electronic wallet as taught by *Teicher* so that central accounts associated with the local electronic wallet can be debited for purchases made off-line with the local electronic wallet.

As per claims 15-20, *Williams et al* further discloses wherein the wallet includes payment mechanisms such as bank account information, electronic currency, credit card and debit card information (Col. 15, lines 32-49); identity authentication mechanisms such as personal identification information and authentication information including certificates (Col. 15, lines 32-67 and Col. 37 lines 45-63); and wherein personal information comprises name and address information (Figures 15 and 29).

As per claim 21, *Williams et al* further discloses a virtual wallet system wherein the electronic artifacts include loyalty programs and coupons (Col. 19, lines 50-55).

As per claim 22, *Williams et al* further discloses wherein the external server residing portion includes a mirror of information contained on the locally residing wallet portion (Col. 11, lines 35-56).

8. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Williams et al*, U.S. Patent No. 6,016,484 and *Teicher*, U.S. Patent No. 5,744,787 as applied to claim 14 above, and further in view of *Biffar*, U.S. Patent No. 5,903,880.

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As per claims 23 and 24, *Williams et al* and *Teicher* fail to specifically disclose wherein the external server residing portion includes applications and the locally residing wallet portion comprises connectors to the applications that reside on the external server residing portion. *Biffar* discloses a system that creates and transfers digital vouchers and includes remote devices such as smart cards and a central server system (Col. 6, lines 33-39 and Col. 8, lines 18-40). *Biffar* also discloses that the remote devices include a memory portion for storing vouchers or the user can store some or all of the user's vouchers in an account on an external server (Col. 8, lines 60-67) and the user has the capability to establish contact with the external server and utilize applications to perform a number of different functions regarding the accounts (Col. 8, lines 1-18 and Col. 8 line 64-Col. 9 line 34). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the external server application features taught by *Biffar* into the system of *Williams et al* and *Teicher* as this feature would enable the user to manage wallet information stored on the external server.

Conclusion

9. This is a Continued Prosecution Application of applicant's earlier Application No. 09/190,993. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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10. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Hayashida discloses an electronic cashless system comprising a cashless medium and an associated bank center account that allows a consumer to purchase goods with the cashless medium at a merchant facility wherein the merchant redeems the cashless credits from the bank center
- Demers et al disclose a method for verifying electronic payments through the use of smart cards wherein the customers bank account is debited and the merchants bank account is credited to pay for the purchases by the consumer
- Kasai et al disclose electronic money holding devices for allowing consumers to make payments for purchases electronically
- Bitoh discloses an IC card system in which either an on-line transaction or an off-line transaction can be made
- Gutman et al discloses an electronic wallet including a memory for storing a balance that corresponds to an account in a financial institution
- Pitroda discloses universal electronic transaction card capable of serving as a number of different credit cards, bank cards, ID cards, employee cards, etc. and is linked to a mainframe computer which stores customer account information
- Chen et al discloses a cyber wallet in the form of stored account information on a smart card and includes multiple credit cards with multiple issuers in a convenient package designed to enable the owner to make purchases over the Internet
- Carlisle et al discloses a system and method wherein consumers may purchase items by debiting any of a plurality of accounts stored on a smart card
- Williams et al [5,815,657] discloses an electronic monetary system for transactions utilizing an electronic wallet or purse used for storing money, credit cards and other forms of payment
- Jonstromer discloses an electronic transaction terminal for use in conduction financial transactions using an electronic wallet in the form of a smart card and a communications module.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

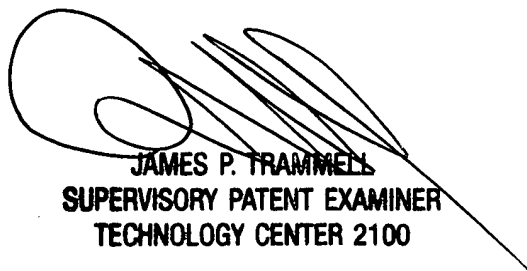
The Fax phone number for the **UNOFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 305-0040 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

The Fax phone number for the **OFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 308-9051 or 9052 (for formal communications intended for entry).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Jwh

07 June 2001


JAMES P. TRAMMELL
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